

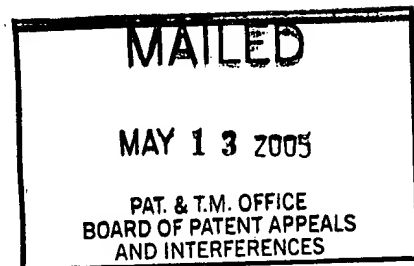
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HEATH B. CLARKE

Appeal No. 2005-0507
Application No. 09/653,095

ON BRIEF



Before THOMAS, BARRY, and MACDONALD, ***Administrative Patent Judges***.

MACDONALD, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-25.

Invention

Appellant's invention relates to a cascading menu system and method.

An embodiment of the present invention provides a user with a cascading menu. The cascading menu is dynamically generated using a program language such as Visual Basic, from a text file that specifies parameters of the cascading menu. The cascading menu can automatically provide sub-categories such that a user can easily locate desired products and services. For example, a cursor can float over a menu item or the user can click on a menu item and the system can respond with a further sub-classification of the menu item. The text file can be stored locally on a user's

machine such that upon subsequent accesses, the menu can be updated with relatively small changes to the text file as opposed to a download of the entire text file. The selecting of objects and searches from the cascading menu can earn the user credits or micro-credits. The credits can be applied to purchases from a provider of the cascading menu. Advantageously, the credits from the provider can avoid or reduce transaction costs, which can undermine the economic feasibility of small quantity or low cost transactions. Selection of a menu item can activate a search by a commerce server. In one embodiment, the search or search activation can also earn the user credit or micro-credit. The search by the commerce server can return a web page of items conforming to the products or services indicated by the menu item. For example, where the menu item corresponds to 17-inch computer monitors, the web page can return a list of available 17-inch monitors from a variety of vendors. The web page can advantageously rank or arrange goods or services in an order of aggregate cost. The commerce server can combine a bare product cost with additional costs, such as shipping, handling, insurance, and sales tax, and the commerce server can account for disparities in additional costs by locale by locale by accessing a database containing the user's shipping address. In one embodiment, the commerce server provides an online bidding system such that a vendor can change the vendor's bare product cost or additional cost to change the vendor's ranking within a web page.

Appellant's specification at page 1, line 24, through page 2, line 25.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method of providing access to information relating to a plurality of products using a cascading commerce menu, comprising:
 - providing a first level menu listing a first set of product categories;
 - detecting a position of a cursor over a first product category listed in said first set of product categories; and
 - providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position.

References

The references relied on by the Examiner are as follows:

Scroggie et al. (Scroggie)	6,185,541	Feb. 6, 2001 (Filed May 12, 1999)
Sanford et al. (Sanford)	6,256,028	Jul. 3, 2001 (Filed Aug. 14, 1998)
Shkedy	6,260,024	Jul. 10, 2001 (Filed Dec. 2, 1998)
Axaopoulos et al. (Axaopoulos)	6,286,002	Sep. 4, 2001 (Filed Nov. 14, 1997)

Rejections At Issue

Claims 1-3, 6-7, and 25 stand rejected under 35 U.S.C. § 102 as being anticipated by Sanford.

Claims 4-5, 8, and 14 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Sanford and Axaopoulos.

Claims 9-13 and 19-20 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Sanford, Axaopoulos, and Shkedy.

Claims 15-18 and 22-24 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Sanford, Axaopoulos, and Scroggie.

Claim 21 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Sanford and Scroggie.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1-3, 6-7, and 25 under 35 U.S.C. § 102, and we reverse the Examiner's rejections of claims 4-5 and 8-24 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellant has indicated that for purposes of this appeal the claims stand or fall together in four groupings:

¹ Appellant filed an appeal brief on April 7, 2004. The Examiner mailed an Examiner's Answer on June 22, 2004.

Claims 1-3, 6-7, and 25 as Group I;
Claims 4-5, 14, and 18, as Group II;
Claims 8-13 and 19-20 as Group III; and
Claims 15-17 and 21-24 as Group IV.

We will, thereby, consider Appellant's claims as standing or falling together in the four groups noted above, and we will treat:

Claim 1 as a representative claim of Group I;
Claim 4 as a representative claim of Group II;
Claim 8 as a representative claim of Group III; and
Claim 21 as a representative claim of Group IV.

I. Whether the Rejection of Claims 1-3, 6-7, and 25 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Sanford does fully meet the invention as recited in claims 1-3, 6-7, and 25. Accordingly, we affirm.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 1, Appellant argues at page 9 of the brief, “[t]here is no mention of products, goods, or commerce in the Abstract or in Figure 7 [of Sanford]” and “Sanford does not discuss products, goods, or commerce.” The

Examiner points out at pages 4-5 of the answer that such "phrase(s) and word(s) are given little patentable weight as they are non-functional descriptive material" which is directed only to the content of the data. We find Appellant's argument to be unpersuasive.

In our review of claim 1, we find that the claimed "product categories" and "product subcategories" are text to be displayed on a computer terminal or display (specification at page 4, lines 14-15). Further, we find that such text is nonfunctional descriptive material, and as such, we give the content of the text no patentable weight. We find before us a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. We find that the difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material. Nonfunctional descriptive material cannot render patentable an invention that would have otherwise been anticipated. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 4-5, 14, and 18 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 4-5, 14, and 18. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the

reasoning by which the findings are deemed to support the agency's conclusion.”

In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to dependent claim 4, Appellant argues at pages 15-16 of the brief, “the Examiner’s [motivational] statement is merely a broad, conclusory statement regarding the benefits of comparative shopping in general, and does not identify a suggestion or motivation to combine the references.” We agree.

To reach a finding of obviousness, either an express, written motivation to combine must appear in prior art references, or the examiner may find a motivation to combine prior art references in the nature of the problem to be solved. ***Ruiz v. A.B. Chance Co.***, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004); ***Also Pro-Mold & Tool Co. v. Great Lake Plastic Inc.***, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630; ***In re Huang***, 100 F.3d 135, 139 n.5; 40 USPQ2d 1685, 1688 n.5 (Fed. Cir. 1996). We find neither present in the rejection before us. Nor has the Examiner shown that the motivation, suggestion or teaching is from the knowledge of one of ordinary skill in the art. ***In re Kotzab***, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). We find that the Examiner has not met the initial burden of establishing a ***prima facie*** case of obviousness.

Therefore, we will not sustain the Examiner’s rejection under 35 U.S.C. § 103.

III. Whether the Rejection of Claims 8-13 and 19-20 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one

of ordinary skill in the art the invention as set forth in claims 8-13 and 19-20.

Accordingly, we reverse.

With respect to dependent claim 8, Appellant argues at page 12 of the brief, "Axaopoulos fails to disclose any mention of ranking" and "Figure 22 does not show aggregate costs [which are the basis of the ranking]." We agree.

We have reviewed the Axaopoulos reference and fail to find the claimed "ranking" limitations in the reference. We find that figure 22 of Axaopoulos shows two products with the more costly product displayed first. However, the Examiner points to nothing in Axaopoulos to show that there was any intent (i.e., ranking) to Axaopoulos' sequencing of the display of the two products. We also note that we find no motivation for combining the Sanford and Axaopoulos references as discussed above with respect to claim 4. We find that the Examiner has not met the initial burden of establishing a *prima facie* case of obviousness.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

IV. Whether the Rejection of Claims 15-17 and 21-24 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 15-17 and 21-24.

Accordingly, we reverse.

With respect to independent claim 21, Appellant argues at page 14 of the brief, "Scoggie teaches purchasing incentives or coupons" and "purchasing incentives or

coupons differ fundamentally from rewards.” Although Appellant has overstated the difference between purchasing incentives, coupons, and rewards, we agree with the basic argument that incentives and coupons are different from rewards. We note that incentives, coupons, and rewards are all something of value given in return for performance of a desired behavior. However, the incentives and coupons of Scoggie are given before the performance of the desired behavior (purchasing the product). Appellant defines “reward” as something that is “earned” in the specification at line 8 of page 7. We find that “earned” requires that the reward be given only after performance of the desired behavior. The Examiner’s rejection fails to discuss this limitation. We find that the Examiner has not met the initial burden of establishing a ***prima facie*** case of obviousness.

We also note that it might be argued that it is old and well known in the art to provide a reward in return for desired behavior in any commercial environment. However, that is not the rejection before this panel.

Therefore, we will not sustain the Examiner’s rejection under 35 U.S.C. § 103.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 102 of claims 1-3, 6-7, and 25, and we have not sustained the rejection under 35 U.S.C. § 103 of claims 4-5 and 8-24.

AFFIRMED-IN-PART

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